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OFFICE OF PETITIONS

In re Application of	:	
Fan et al	:	
Application No. 09/863,318	:	DECISION GRANTING PETITION
Filed: May 24, 2001	:	UNDER 37 CFR 1.181
Attorney Docket No. 4172P	:	

This is a decision on the petition under 37 CFR 1.313(b)(1), filed October 29, 2007, by a third party, and on the petition filed November 2, 2007, by the true party in interest, to withdraw the above-identified application from issue after payment of the issue fee due to USPTO error, which is being treated as a petition under 37 CFR 1.181 (no fee) to correct the record after reviewing the actions of the USPTO in accepting the revocation and power of attorney by the putative assignee, and the impending issuance of this application to the incorrect assignee.

The petition filed November 2, 2007 by Squire Sanders & Dempsey on behalf of Broadcom is **GRANTED to the extent indicated.**

No action will be taken with respect to the third party papers filed October 29, 2007.

Petitioner, former counsel of record on behalf of Broadcom Corporation ("Broadcom"), variously asserts and inspection of the record also reveals that (1) Broadcom was and remains the assignee of the entire interest, (2) Adtran Inc., ("Adtran") became of record within the meaning of 37 CFR 3.73 and MPEP 324 on March 29, 2007, as the putative successor in title to Luminous Networks ("Luminous"), notwithstanding that there is no record chain of title from Broadcom to Luminous, (3) Adtran erroneously executed a Revocation and Power of attorney via a certification under 37 CFR 3.73(b) executed by that revoked his power and appointed counsel associated with customer no. 29141 (Sawyer Law Group of Palo Alto CA ("Sawyer")), (4) the Notice of Allowance was duly mailed to Sawyer, (5) Sawyer paid the issue fee on September 27, 2007, requested on the issue fee transmittal (PTOL 85) that the patent issue to Adtran as the assignee.

Petitioner requests that the original power be restored, that this application be withdrawn from issue under the provisions of 37 CFR 1.313(b), and that the assignment records of the USPTO be

corrected where the documents filed by Sawyer on behalf of Adtran and recorded against, *inter alia*, this applicaiton wrongly indicate that Adtran is the assignee of the entire interest herein.

Initially 37 CFR 1.313(b) speaks only to the USPTO acting on its own volition, and as such does not provide a basis on which any party—the applicant, the assignee of the entire interest or another other party, may seek withdrawal of an application from issue. Nevertheless, the situation encountered in this application is particularly egregious and as such the USPTO will act unilaterally to provide a public service and not permit this application to issue to party that has no basis on the record herein or in the records of the USPTO to seek issuance of this application to itself as the alleged assignee of the entire interest as permitted by 35 USC 152 and 37 CFR 3.81.

Under 37 CFR 3.71, the assignee of the entire interest may prosecute an application to the exclusion of the named inventors, or any previous assignee, and also revoke, or appoint, a power of attorney in an application or patent. Pursuant to 37 CFR 3.73(b), that putative assignee must present its showing consonant with 37 CFR 3.71 to the Office, either prior to, or concurrently with, the paper that requests the action. Accordingly, Adtran had to establish that it is the current owner of the entire interest, as the owner—or even the equitable owner-- of only a part interest in an application does not have the sole right to control prosecution of the application. See In re Goldstein, 16 USPQ2d 1963, 1964 (Comm'r Pat. 1988; *see also* In re Scold, 195 USPQ 335, 335 (Comm'r Pat. 1976); Ex parte Harrison, 1925 Dec. Comm'r Pat. 122, 123 (Comm'r Pat. 1924). The procedures set forth in the regulations (e.g., 37 CFR 3.73(b)) serve to assure that papers filed with the USPTO in an application or patent are submitted on behalf of the owner(s) of the entire interest in the application or patent. See Goldstein, 16 USPQ2d at 1964; MPEP 324.

As Petitioner correctly notes, there is no evidence recorded at the USPTO showing that any party, much less either Luminous or Adtran, is the successor of the rights title and interest of Broadcom in this application. The certification under 37 CFR 3.73(b) executed by Kevin Schneider on behalf of Adtran had to show where the recorded chain of title reflected the succession of conveyances from the named inventors to Broadcom and from Broadcom to Luminous, and thence from Luminous to Adtran. Schneider indicated (wrongly) that there was but a single document recorded against this application and thus implied that the inventors had directly conveyed their rights to Adtran. Indeed, the recorded document referenced by Schneider only shows a transfer of title from Luminous to Adtran, and as such is fatally defective for the intended purpose. The USPTO erred in accepting the express and implied representations of Schneider, and in appointing Sawyer, and any inconvenience to the true party in interest and former counsel is sincerely regretted.

Third party and its representative are placed on notice that the Office considers the filing of a petition or other paper on behalf of a party having no standing in an application, and not otherwise authorized by the rules of practice, to be a petition or paper presented for an improper purpose (37 CFR 10.18). For example, the filing of a paper on behalf of a party in situations not authorized by the rules of practice delays the examination and processing of applications, which may cause harm to the general public if it results in the Office missing any one of the examination time frames specified in 35 U.S.C. §§ 154(b)(1)(A) or 154(b)(1)(B). Therefore, the Office may refer any improper third party papers in this or any other application to the Office of

Enrollment and Discipline for appropriate action. See “Third Party Attempts to Protest or Otherwise Oppose the Grant of a Published Application,” 1269 *Off. Gaz. Pat. Office* 179 (April 22, 2003). Here, the third party sought to oppose the grant of this application to the record assignee by posturing itself as the true assignee of the entire interest.

As to the request for correction of the assignment records of the USPTO, that is in fact a matter for petitioner to pursue. The USPTO records assignment documents submitted to it in a purely ministerial capacity. As set forth in 37 CFR 3.54, and MPEP 317.03, the recordation of a document proffered as an “assignment” is not a determination by the Office of the validity of the document or the effect that document has on the title to an application or patent. Assuming that Adtran caused to be recorded documents that do not accurately reflect the correct rights title and interest to this application, then petitioner may wish to consult with Adtran to see if Adtran will itself record corrective documents to clarify the true ownership of this application. See MPEP 323.01(b). If petitioner cannot prevail upon Adtran, then he may wish to himself record additional documents that clarify the ownership of this application consistent with petitioner’s viewpoint. *Id.*; see also MPEP 323.01(c).

Petitioner’s observation about the third party’s comments on the reasons for allowance are noted. Should petitioner wish, he may separately request under 37 CFR 1.59 that they be expunged from the record, and he may in turn present any comments that he wishes to make upon his forthcoming receipt of the Notices of Allowance and Allowability.

This decision is also notice to Sawyer that its improperly recognized power is **revoked** and the former power is **restored** to SQUIRE, SANDERS & DEMPSEY L.L.P.

The above-identified application is withdrawn from issue so that the Notices of Allowance and Allowability may be remailed to the correct correspondence address and, should the record assignee of the entire interest desire that this application issue to itself as permitted by 35 USC 152 and 37 CFR 3.81, it may take the appropriate action in that regard.

This application is being referred to the TC for further action consistent with this decision.

Petitioner is advised that the issue fee paid on September 27, 2007 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.¹

¹ The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.

Telephone inquiries should be directed to the undersigned at (571) 272-3217.

A handwritten signature in black ink, appearing to read 'Brian Hearn', with a stylized flourish at the end.

Brian Hearn
Petitions Examiner

cc:

Sawyer Law Group LLP
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